



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/675,938	09/29/2000	James E. McShane	FC0807Q1	1065

24265 7590 12/31/2002

SCHERING-PLOUGH CORPORATION
PATENT DEPARTMENT (K-6-1, 1990)
2000 GALLOPING HILL ROAD
KENILWORTH, NJ 07033-0530

EXAMINER

SHARAREH, SHAHNAM J

ART UNIT	PAPER NUMBER
----------	--------------

1617

DATE MAILED: 12/31/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/675,938

Applicant(s)

MCSHANE, JAMES E.

Examiner

Shahnam Sharareh

Art Unit

1617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 October 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: |

Art Unit: 1617

DETAILED ACTION

1. Amendment filed on October 8, 2002 has been entered. Claims 1-10 are pending. Applicant's arguments filed October 8, 2002 have been fully considered but they are not persuasive for the reasons set forth below. Any rejection that is not addressed in this Office Action is considered obviated in view of the Arguments.

Response to Arguments

2. Claims 1-10 are rejected under 35 U.S.C. 102(b) as being anticipated by Nakane et al US Patent 5,122,418.

Applicant argues that there is no mention of solvent in combination with the zinc oxide and propellant. In response, Examiner states that the definition of solvent is interpreted given its broadest reasonable interpretation consistent with the specification. Accordingly, any organic solvent meets such limitation of "a solvent." Examples 35-37 of Nakane comprise zinc oxide, propellants, such as Freons, and isopropyl myristate and diglyceryl tetra-2-ethylhexanoate which meet the limitation of a solvent. Furthermore, Nakane explicitly discloses the use of various compounds that are organic or inorganic solvents such as cetyl alcohol, hexadecyl alcohol, oleyl alcohol, isopropyl myristate, and even water (see col 10, lines 7-19). Thus, Nakane anticipates the limitations of the instant claims.

In response to applicant's argument that Nakane's compositions are not pressurized aerosol for treating food and/or shoe odors, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from

Art Unit: 1617

the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

3. Claims 1-10 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Lajoie US Patent 5,466,470 in view of Lisboa et al US Patent 5,679,324.

Applicant merely argues that the teachings of the cited references amount to a general concepts in the art and there is no specific teachings in the cited art to make the instant products. In response Examiner states the that obviousness can be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). Furthermore, the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).

In the instant case, not only general the knowledge generally available in the art provides ample motivation to combined the teachings of the cited references, but also combining the elements of the pending claims would flow naturally from following the suggestion of the prior art. The instant claims require micronized zinc oxide, a solvent, a

Art Unit: 1617

propellant and a fragrance. The claims are not directed to any specific species of such elements. Examples 3-4, and claims 1-5 of Lajoie only provides two such topical compositions that include at least a zinc oxide, a solvent and a fragrance. Lajoie lacks a propellant. This deficiency is met by the general teachings of Lisboa, because Lisboa not only teaches topical compositions that contain propellants but such topical compositions can contain zinc oxide (col 8, lines 15-17). Accordingly, it would flow naturally from the teachings of the art that the difference between the cited references and the instant claims are obvious and one of ordinary skill in the art would have been motivated to use a propellant with the compositions of Lajoie.

During prosecution of Patent Application, when an examiner obtains a product which reasonable appears to fall within the scope of that which is claimed by a patent applicant, it is reasonable to shift the burden to the applicant to provide evidence showing that the product of the prior art does not fall within the scope of applicant's claims. see *In re Spada*, 911 F.2d 705, 15 USPQ2d 1655 (Fed Cir 1990). In the instant case, Examiner has set forth ~~in Lisbon~~^{in Lajoie} such reasons. Specifically, in the Office Action Lajoie is explained to teach topical use of the compositions for various reasons (see col 4, lines 30-37), and that such compositions can further contains a fragrance. One of ordinary skill in the art looking at such examples could easily ascertain that peppermint oil is an example of a fragrance and ethanol and water are examples of solvents. Here, Applicant's merely alleges that the cited references do not teach the instantly claimed invention without specifically pointing out how the language of the claims patentably

Art Unit: 1617

distinguishes. Nor is there any scientific or legal evidence provided to indicate otherwise. Thus, the arguments are not persuasive.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). In the instant case, both cited references are in the same field of endeavor and are combinable as suggested in the Office Action. Thus, the conclusion is not based on improper hindsight, rather, *prima facie* obviousness.

Finally, Applicant's reliance on *In re Freed*, 165 USPQ 570, is misplaced as the instant case is not analogous to *Freed*. Specifically, the obviousness conclusion is not based on unsupported generalities, rather specific teachings within the cited references. In *Freed*, the Court reasoned that the PTO's conclusion, which must have some support, either in logic or in cold, hard facts. Accordingly, the Court concluded that no evidence was submitted to support PTO's conclusion and the ordinary skill in the art required to infer the point of novelty in question from the secondary Italian reference. *Id.* at 571-572.

Contrary to *Freed*, there are specific recitations in the secondary reference that propellants are used in cosmetic compositions containing active drugs such as

Art Unit: 1617

antifungals, sunscreens etc,... a fragrance and a suitable cosmetic vehicle (see abstract of Lisboa). Lisboa then teaches various moieties including micronized metal oxide powders in such compositions (see col 8, lines 11-20). No unsupported generalities exist in the conclusion of the instant rejection, because these teachings are explicitly stated in Lisboa. Nor is there any inference required by an ordinary skill in the art to reach the conclusion that a propellant can be used in combination with zinc oxide powder, a solvent and a fragrance. For such reasons, Applicant's arguments are not found persuasive.

Conclusion

No claims are allowed. THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shahnam Sharareh whose telephone number is 703-306-5400. The examiner can normally be reached on 8:30 am - 6:00 pm.

Art Unit: 1617

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreenivasan Padmanabhan, PhD can be reached on 703-308-1877. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-4556 for regular communications and 703-308-4556 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1123.

ss
December 24, 2002


RUSSELL TRAVERS
PRIMARY EXAMINER
GROUP 1200